

Docket No.: 60154.302001

Patent

REMARKS

It is our understanding that claims 1-20 remain pending in this application.

It appears that the present claim rejections are exactly the same as appeared in the last Action. Responsive thereto, Applicant incorporates by reference its Remarks in its last Response and urges their reconsideration.

We turn now to the Response to Arguments portion of the present Action, which states:

The thrust of the applicant's arguments center around the fact that the combined device of Lau and Thiel as discussed above is in error because the combined device fails to disclose the multiple-axis (as argued, 5-axis) measurement of the instant invention. However, nowhere in the claim language is such a measurement disclosed. The claims are directed to a measuring apparatus and method, yet no specific type of measurement is claimed. Accordingly, since the claims are not directed to any sort of specific 5-axis measurement, the prior art of record reads on the claimed subject matter. Arguments as to how the specification or title of the application overcomes the prior art of record are moot, since only what is claimed is relevant.

Respectfully, the Examiner has missed some subtle points here. The general structure of our argument is that two systems that produce different results cannot be the same. Thus, the proposed combined device of Lau and Thiel, which is incapable of 5-axis measurement, cannot be the same or equivalent to the claimed invention, which is capable of 5-axis measurement.

The Examiner has correctly noted that the claims do not explicitly recite 5-axis measurement. However, we have shown that there are significant differences in the elements and steps of the proposed combination of Lau and Thiel and in the claimed invention, and that those differences provide clear benefits (e.g., 5-axis measurement). Our remarks about the specification and the title bear on those benefits. That benefits be recited in the claims themselves is simply not a requirement of U.S. patent law, and therefore is not determinative here.

The Response to Arguments next states:

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes [1] that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. [cites omitted] [2] In this case, the examiner relied on Thiel only for the dual channel measurement. [3] The examiner disagrees with the applicant's assertion that the Thiel device is only a

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single channel; [4] each path of the Thiel device has its own detector set. Light traveling through one beam splitter to its corresponding corner cube on the measurement device remains in that path; there is no mixing between light from the first corner cube and light from the second corner cube. [5] As a result, the examiner holds that the Thiel device has two channels. [6] This two-channel arrangement is the only teaching the examiner is taking from Thiel, and the combination stands, especially since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. [cites omitted](reference numbering added)

But this begs the question, where then is the suggestion or motivation? The Examiner here merely:

- [1] acknowledges that such is required;
- [2] states what technical feature he relies on in Thiel;
- [3] disagrees with Applicant's interpretation of what Thiel teaches;
- [4] restates his interpretation of what Thiel teaches;
- [5] states his holding that Thiel teaches what he says it teaches;
- [6] restates that "*this ... is the only teaching*" he is taking from Thiel (when he apparently means to state that he feels that what Thiel teaches supports his holding); and
- [7] states that the "combination stands."

However, the combination cannot stand if there is no suggestion or motivation to combine Lau and Thiel, and none has yet been stated.

Furthermore, Applicant's original points about suggestion or motivation were in the context of the three-part test that must be met to establish a *prima facie* case of obviousness. We respectfully again submit that none of those three criteria have been met, and we observe that there is no apparent effort in the present Action to rebut our remarks about the other two criteria.

In closing the Response to Arguments states:

Finally, while the examiner appreciates the pointing out of the modulation disclosure overlooked in the Thiel reference, the Official Notice that was taken with regards to claims 11, 16, and 19-20 stands, particularly in light of US Pat. No. 3,738,754 to Marcy (Fig. 1 and relevant disclosure) in response to the challenge of support with adequate evidence as to the Official Notice for these claims. It is noted that the Official Notice for claim 9 has not been challenged and therefore stands as prior art.

Respectfully, this merely reiterates that the Examiner is taking Official Notice. It does not, as was specifically requested in the last response, "*support [such] finding with adequate evidence (MPEP 2144.03(C))*" and it does not rectify that "*the technical line of reasoning*

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underlying [the application of such] *is not clear and unmistakable (MPEP 2144.03(B)).*" If the Examiner wishes to argue Marcy, then we respectfully call upon him to substitute it for his challenged Official Notice and to then argue Marcy with requisite specificity to provide Applicant a reasonable opportunity to reply.

As regards Official Notice and claim 9, our failure to challenge was intentional. We concede that photodiodes are well known in the art for interferometer fringe measurement and detection.

CONCLUSION

Applicant has endeavored to put this case into complete condition for allowance. It is thought that the §103 rejections have been completely rebutted. Applicant therefore asks that all objections and rejections now be withdrawn and that allowance of all claims presently in the case be granted.

Intellectual Property Law Offices
1901 S. Bascom Ave., Suite 660
Campbell, CA 95008

Telephone: 408.558.9950
Facsimile: 408.558.9960
E-mail: RRoberts@iplo.com

Respectfully Submitted,



Raymond E. Roberts
Reg. No.: 38,597

Customer No.:

32112